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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,143

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Francis M. Sherwin

PRA 2 0006

1378

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EXAMINER

KIM, NICHOLAS J

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,143

Applicant(s)

SHERWIN ET AL.

Examiner

Nicholas Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1, 3-5, 7 and 10-11 are objected to because of the following informalities: In Claim 1: delete the comma after “and” in step (d); In Claim 3: at line 3, delete the comma after “and”; In Claim 4: at lines 2-3, “from, and based thereon determining” should read “from; and based thereon, determining”; In Claim 5, “that shopper” at line 10 should read “each shopper”, and “their associated affinity group on their behalf” at lines 11-12 should read “the shopper’s associated affinity group on the shopper’s behalf.” In Claim 7: “in step (b), forwarding each shopper to their” at line 4 should read “in the step of forwarding”; In Claim 10: “in step (a)” at line 3 should read “in the step of receiving, forwarding each shopper to the shopper’s”; In Claim 11: “mean” at line 2 should read “means”, “they” at line 10 should read “the shoppers”, and “their” at line 14 should read “the shoppers”. Appropriate correction is required.

2. Additionally, Applicants are advised that should Claim 1 be found allowable, Claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 1-4, 5-10, and 17 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In particular, Claims 1 and 5 recites the limitation “how much was distributed” in step (e) of both claims. The precise scope and meaning of this phrase is unclear. Accordingly, for the purpose of expediting examination, “how much was distributed...” is interpreted to mean “the portion distributed...”

6. Additionally, Claim 4 recites “determining where the first web-site receives the shopper from...” at line 2. The meaning of this phrase is unclear. Accordingly, for the purpose of expediting examination, this phrase is interpreted to mean “determining an affinity group associated with the first web-site...”

7. Claim 10 recites “the one” at line 2. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. **Claims 1, 3-5, 7-11, and 17** are rejected under 35 U.S.C. 102(e) as anticipated by Bain (U.S. Patent Pub. No. 2001/0053997).

10. Beginning with Claims 1, 5, and 11, Bain teaches Applicants' claimed invention, including (a) receiving a shopper/shoppers at a first web-site maintained on the communications network, the shopper having an affinity group associated therewith (FIG. 1, "Preference Processing Site (PPS) 10"); (b) forwarding the shopper/shoppers to a (selected one of a plurality of) second web-site/sites maintained on the communications network (Para. 0027, "hyperlinking from the PPS to the Vendor"); (c) obtaining a generated click-through fee related to the forwarding of the shopper/shoppers to the second web-site/sites (Paras. 0024, 0028); (d) distributing a portion of the obtained click-through fee to the respective affinity group associated with the shopper/shoppers (Para. 0030, NPO receives commission from PPS); and, (e) communicating to the shopper/each shopper how much was distributed to their associated affinity group (Paras. 0036-0037, since the specials and incentives such as double points/commissions (Applicants' "how much") are provided to influence the behavior of purchasers, such influence requires that these specials are communicated to purchasers; and Para. 0006, tax deductible gifts necessitate that the actual portion of the purchase donated to an NPO is measurable so a purchaser can file for the appropriate amount of tax deduction).

11. As per Claim 3, Bain discloses determining an amount of purchases made by the shopper at the second web-site and determining the generated click-through fee based on the amount (Para. 0028).

12. With regard to Claim 4 and Claims 9-10 corresponding substantially thereto, Bain teaches determining where the first web-site receives the shopper from, and based thereon

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determining which affinity group is to be associated with the shopper (Para. 0027, accounting tracked; Para. 0033, NPO is pre-selected using a cookie).

13. Turning to Claim 7, Bain discloses providing each shopper with a choice of second web-sites, receiving an indication of each shoppers choice, and forwarding each shopper to their respective choice of second web-sites (Para. 0034, PPS presents a number of Vendors, a selection is made).

14. Addressing Claim 8, Bain describes that the communications network is the Internet (FIG. 1 at 20).

15. Further, Bain teaches means for a representative of an affinity group to create a customized shopping portal for the affinity group (Para. 0030, NPO registers its site and provides additional information to present to a purchaser).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 2, 6, 12, and 13-16** are rejected under 35 U.S.C. 103(a) as unpatentable over Bain.

18. Concerning Claims 2, 6, and 12, Bain explicitly teaches that the purchaser's selection results in a tax deductible gift (Bain at Para. 0006). On the other hand, Bain does not explicitly

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disclose that the shopper's identity is communicated to the affinity group/NPO. However, Official Notice is taken that NPOs often send to donors thank you letters or receipts for donors' tax records recording at least the amount of donations. Such correspondence requires that the NPO have received the identity of the donor/purchaser. Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Bain to include communicating the identity of the shopper/donor for the purpose of sending the shoppers' confirmation of the amount of the donation for the shoppers'/donors' tax records.

19. **Claims 13-16** are rejected under 35 U.S.C. 103(a) as unpatentable over Bain in view of Dorff et al. (U.S. Patent Pub. No. 2001/0025263, herein "Dorff").

20. With regard to Claim 13, Bain does not explicitly teach that if the identifying means does not identify a received shopper that is responsible for a distribution being made by the distributing means, then the communicating means indicates that the distribution is made anonymously. However, Dorff expressly provides these limitations (Dorff at Para. 0026). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Bain to the feature of anonymous giving as taught by Dorff for advantageously enabling a purchaser to experience the satisfaction of charitable giving (Dorff at Para. 0006).

21. As described above with regard to the rejections under 35 U.S.C. 102(e), Bain explicitly teaches the features recited in Applicants' Claims 14-16, including that the forwarding means permits shoppers to choose which shopping site they are forwarded to from a plurality of different shopping sites (Para. 0034), that the portion distributed by the distributing means is

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based upon an amount of purchases observed by the monitoring means (Para. 0028), and that the communications network is the Internet (FIG. 1 at 20).

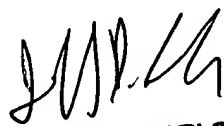
Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK


JEFFREY D. CARLSON
PRIMARY EXAMINER